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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/610,946
Filing Date: June 30, 2003
Appellant(s): BRISHKE ET AL.

Marisa J. Dubuc
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/26/2009 appealing from the Office action mailed 1/22/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,289,340	PURAM ET AL.	9-2001
6,524,109	LACY ET AL.	2-2003
2004/0059583	O'NEILL	3-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 and 16-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1, recites a method of procuring a supplemental worker for a job, comprising the steps of: "receiving a request form", "generating a list of at least one supplier candidate" and "providing said list of at least one supplier candidate." However, the recited limitations, as presented in the claim, are not directed to any form of structure. Based on the recent precedent for the Federal Circuit from *In re Bilski*, the machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-

solution activity. See *Flook*, 437 U.S. at 590. The claimed process contains physical steps that do not involve transforming an article into a different state or thing. Therefore, Applicants' claim is not drawn to patent-eligible subject matter under § 101, because the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the Supreme Court and clarified herein, and Applicants' claim here plainly fails that test. See *e.g. In re Bilski and Warsaw*, (Fed. Cir. 2008).

Claims 2-6 and 16-17, depends from claim 1 and do not cure the deficiencies set forth above. Therefore, claims 2-6 and 16-17 are also rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claims 1, 3-7, 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Puram et al. (US 6,289,340, hereinafter Puram).

As per claim 1, Puram discloses a method of procuring a supplemental worker for a job, comprising:

receiving a request form from a hiring entity for a supplemental worker, said request form including: a work location; (col. 5, line 35-43 preferred geographical region of employment; see also, col. 6, line 54 - col. 7, line 20 position profile, company global hiring rules); and
at least one skill type; a skill level associated with said at least one skill type (col. 5, line 60 - col. 6, line 15 each selected skill is assigned a skill level; see also, col. 4, line 30-53 skills levels); and

a quantity of supplemental workers required for performing said job (col. 7, line 34- 67, employer needs data and satisfactory size); and generating a list of at least one supplier candidate by accessing a data repository, said list of at least one supplier candidate satisfying criteria provided in said request form (col. 7, line 22-27 search result for candidates whose skills profiles match or exceeds specific criteria; see also, col. 8, line 35-46); and providing said list of at least one supplier candidate to said hiring entity (col. 6, line 66 - col. 7, line 2, storage medium consisting of candidate skills; see also, col. 7, lines 4-39, generates a sub-pool of qualified candidates); and wherein said data repository stores predefined skill types, predefined skill levels, supplier locations, and pre-negotiated pay rates (col. 2, line 44-58 storage medium; see also, col.8, line 61 – col. 9, line 10 compare rates charged by each candidate to market rate).

As per claim 3, Puram further discloses wherein said skill types are coded and selectable by said hiring entity (col. 4, lines 6-22 auxiliary table correlates a numerical value with specific skill or experience level, technical skill table).

As per claim 4, Puram further discloses wherein said request form includes an editable text field operable for entering a skill type (col. 3, lines 50-58 tables or worksheets where candidate enters or alters skill type and skill level).

As per claim 5, Puram further discloses wherein said request form includes a pay category option operable for calculating a salary (col.8, line 61 - col. 9, line 10 market analysis and pay rate based on a short list of qualified candidates).

As per claim 6, Puram further discloses wherein information relating to said list of at least one supplier candidate is stored in said data repository, said information including: a supplier name; a supplier address; a supplier telephone number; a point of contact; and pre-negotiated pricing information based upon skill types and skill levels (col. 2, line 59 – col. 3, line 17 database for candidate skills information).

As per claim 7, Puram further discloses a storage medium encoded with machine-readable computer program code for procuring a supplemental worker for a job, said storage medium including instructions for causing a computer to implement: receiving a request form from a hiring entity for a supplemental worker, said request form including: a work location; at least one skill type; a skill level associated with said at least one skill type; and a quantity of supplemental workers required for performing said job; generating a list of at least one supplier candidate by accessing a data repository, said list of at least one supplier candidate satisfying criteria provided in said request form; and providing said list of at least one supplier candidate to said hiring entity; wherein said data repository stores predefined skill types, predefined skill levels, supplier locations, and pre-negotiated pay rates (col. 2, lines 35-58 apparatus, system, and method use relational databases; see also, Figs. 1a-1b, and associated text).

As per claim 9, Puram further discloses wherein said skill types are coded and selectable by said hiring entity (col. 4, lines 15-22 and col. 4, lines 54-67 auxiliary table wherein skill level is correlated with a numerical value; see also, col.5, lines 29-34 storage medium).

As per claim 10, Puram further discloses wherein said request form includes an editable text field operable for entering a skill type (col. 4, lines 54-67 candidate enters or alters skills in a table; see also, col.5, line 29-34 storage medium).

As per claim 11, Puram further discloses wherein said request form includes a pay category option operable for calculating a salary (col. 8, line 47 – col. 9, line 10 apparatus used to perform market price analysis and pay rate for candidate in respect to skills; see also, col.5, line 29-34 storage medium).

As per claim 12, Puram further discloses wherein information relating to said list of at least one supplier candidate is stored in said data repository, said information including: a supplier name; a supplier address; a supplier telephone number; a point of contact; and pre-negotiated pricing information based upon skill types and skill levels (col. 5, lines 29-43 storage medium associated with information for the candidate).

Claims 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Neill (US 2004/0059583) or Puram.

As per claim 13, O'Neill and Puram disclose a host system in communication with at least one hiring entity, at least one supplier entity, and a commodity council entity, said host system (O'Neill: ¶ [0029-0031, talent management system coupled with at least one workplace company and multiple supplier entities]; Puram: col. 3, lines 17-45, computer connected via network with candidate entity, employer entity, and a database; see also Fig. 1c and associated text) comprising:

a server executing a requisitioning tool, a procurement engine, and a workflow application (O'Neill: ¶ [0029-0030, server, Fig. 1 item 120]; Puram: col. 3, lines 30-39, server that carries and access databases which stores and process data, see also Fig. 1c, item 55); and

a data repository in communication with said server via a network, said data repository storing predefined skill types, predefined skill levels, supplier locations, and pre-negotiated pay rates (O'Neill: ¶ [0028-0029 and 0033, database comprising information related to supplier entities, see also Fig. 1 item 115];

Puram: col. 2, lines 44-58, storage medium, see also Fig. 1a, item 10); and

a supplemental workforce system executing on said server (O'Neill: pg. 2, [0031, workplace manager operating in a webserver; see also Fig. 1, item 110]; Puram: Fig.1b, item 25, network and internet server); and

a request form generated by said supplemental workforce system; (O'Neill: pg. 3 [0038 reports; see also, Fig. 4 item 470]; Puram: col. 3, lines 50-67, tables or worksheets, see also Figs. 5-11b, and associated text).

Puram discloses wherein said supplemental workforce system performs: receiving a completed request form from a hiring entity for a supplemental worker, said completed request form including a work location (col. 5, line 35-43, preferred geographical region of employment; see also, col. 6, line 54 - col. 7, line 20, position profile, company global hiring rules); and at least one skill type, a skill level associated with said at least one skill type (col. 5, line 6 - col. 6, line 15, each selected skill is assigned a skill level; see also, col. 4, line 30-53, skills levels); and a quantity of supplemental workers required for performing said job (col. 7, line 34- 67, employer needs data and satisfactory size); and generating a list of at least one supplier candidate by accessing said data repository, said list of at least one supplier candidate satisfying criteria provided in said completed request form; and providing said list of at least one supplier candidate to said hiring entity (col. 6, line 66 - col. 7, line 2, storage medium consisting of candidate skills; see also, col. 7, lines 4-39, generates a sub-pool of qualified candidates).

As per claim 14, O'Neill and Puram further disclose wherein said supplemental workforce system automatically transmits said completed request form with an

approved supplier candidate to said requisitioning tool operable for generating a requisition (O'Neill: ¶ [0035-0038, purchase order approval and reports are automatically generated]; Puram: col. 7, lines 5-20, computing device that performs automated data processing, see also Fig. 3, and associated text).

As per claim 15, O'Neill and Puram further disclose wherein said supplemental workforce system automatically transmits said requisition to said procurement engine operable for generating a purchase order (O'Neill: ¶ [0038-0040, reports automatically generated in accordance with workflow and a purchase order request interface]; Puram: col. 8, lines 30-60, apparatus, system, and method provides instantaneous searching and matching).

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puram in view of O'Neill.

As per claim 2, Puram discloses claim 1 as rejected above but does not explicitly disclose upon acceptance of said request form, automatically transmitting said request form to a requisitioning tool, said requisitioning tool operable for generating a requisition; and upon approval of said requisition, automatically transmitting said requisition to a procurement engine, said procurement engine operable for generating a purchase order.

However, O'Neill teaches wherein reports are automatically generated in accordance with workflow once a purchase order is approved and wherein

automatic reminders or notices are sent to the designated parties which assist in managing the talent and provides a screen shot of a menu that allows selection for creating new purchase orders (¶ [0038-0039 reports automatically generated, confirming approval, manage procurement and administration, creating new purchase orders; see also ¶ [0008, providing reports and automated notices]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the computer hosted method and system of Puram by including a process that automatically generates a request form as taught by O'Neill in order to provide a method and system with comprehensive reporting which will therefore improve back office processes and will provide for best service practices.

As per claim 8, Puram discloses claim 7 as rejected above but does not explicitly disclose the storage medium of claim 7 further comprising instructions for causing said computer to implement: upon acceptance of said request form, automatically transmitting said request form to a requisitioning tool, said requisitioning tool operable for generating a requisition; and upon approval of said requisition, automatically transmitting said requisition to a procurement engine, said procurement engine operable for generating a purchase order.

However, O'Neill discloses a computer readable media that executes instructions and interfaces with different fields that gather and store information from a

database (§ [0028, computer executed instructions stored in a computer readable media; and § [0031-0032, fields in the interfaces that are automatically filled with prior purchase order information gathered from database; see also § [0038-0039, reports are automatically generated in accordance to workflow rules]; see also § [0054 screens are one example of interface]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the computer hosted method and system of Puram by including a database where information is stored and inputted via an interface as taught by O'Neill in order to be more efficient and minimize the efforts or time to generate new purchase orders.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puram in view of Lacy et al. (US 6,524,109 B1, hereinafter Lacy).

As per claim 16, Puram discloses claim 1 as rejected above but does not explicitly disclose

wherein hiring entities represent distinct divisions of a business enterprise seeking the supplemental worker, each of the hiring entities distinguished by geographic location, organization structure, and commodity group (Puram: col. 5, lines 35-43, preferred geographical region of employment; see also, col. 6, line 54 - col. 7, line 20, position profile, company global hiring rules).

However, Lacy teaches where entities represented in this structure could include non-profit or government entities or any other type of organizational unit, and multiple corporate divisions by Division 1 through Division N exist within the corporate structure (col.7, lines 50-67 entity hierarchical structure....corporate entity devoted to a particular product line or lines, or located within a particular geographical region...the divisions are further sub-divided into groups; see also, col. 9, lines 13-16, 49-52 particular skill required at the corporate, division, or group level).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the computer hosted method and system of Puram to include the entity hierarchical structure as taught by Lacy in order to facilitate the procurement and administration of temporary staff sourced from multiple vendors to the workplace company.

As per claim 18, Puram discloses claim 7 as rejected above, but does not explicitly disclose wherein hiring entities represent distinct divisions of a business enterprise seeking the supplemental worker, each of the hiring entities distinguished by geographic location, organization structure, and commodity group.

However, Lacy teaches a storage device and where entities represented in this structure could include non-profit or government entities or any other type of organizational unit, and multiple corporate divisions by Division 1 through

Division N exist within the corporate structure (col.7, lines 50-67 entity hierarchical structure....corporate entity devoted to a particular product line or lines, or located within a particular geographical region...the divisions are further sub-divided into groups; see also, col. 9, lines 13-16, 49-52 particular skill required at the corporate, division, or group level; see also, col. 10, lines 5-8 the hierarchical skill structure is stored in a storage device).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the computer hosted method and system of Puram to include a storage device as taught by Lacy in order to facilitate the data capture of the procurement and administration of temporary staff sourced from multiple vendors to the workplace company.

Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puram in view of Lacy and in further view of O'Neill.

As per claim 17, Puram and Lacy disclose claim 16 as rejected above, but do not explicitly disclose wherein each of the commodity groups is managed by an associated commodity council entity, the commodity council entities performing:

negotiating and maintaining agreements with core workforce suppliers.

However, O'Neill discloses a talent management system (TMS) that facilitates the procurement and administration of temporary staff sourced from multiple

vendors all of whom serve as a primary vendor and provides centralized corporate management and negotiation of an agreement between one or more vendors and a workplace company (§ [0005, 0008, 0038, 0050, 0055-0057 system provides the ability to manage the procurement and administration of talent much more easily than dealing with each vendor separately....TMS provides a network based implementation of an improved process that allows workplace managers, with delegated authority, to initiate the procurement of temporary staff from corporate pre-approved suppliers using any one of a familiar manner, such as by calling, emailing or faxing the vendor while still providing]; see also, § [0034; talent management system...block 410 represents a negotiation of an agreement between one or more vendors and a workplace company])).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the management of Puram and staffing requirements of Lacy to include a talent management system as taught by O'Neill in order to provide a method and system that facilitates management of temporary staff by providing tools such as reports and automatic notices to aid in management decisions.

Puram, Lacy and O'Neill do not explicitly disclose wherein adding and changing core workforce suppliers.

However, O'Neill teaches a menu created by a server that identifies functions for a staffing vendor which allows selection of creating new purchase orders, extending, confirming approval, checking, reviewing, adding and editing, reporting, and obtaining a list of service locations (§ [0039]). In addition, O'Neill teaches a direct correlation between the talent management system for facilitating the procurement and administration of temporary staff sourced from multiple vendors where corporate pre-approves suppliers (§ [0055]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify O'Neill to include adding and changing core workforce suppliers within the corporate pre-approval supplier process already disclosed. As per teachings of O'Neill, it is well known in the art to change or update suppliers within corporate pre-approval supplier process based on the corporate decision, goals or needs for the specific company. This would give the company the assurance that all their current or new supplier needs are met on a constant basis.

Puram, Lacy and O'Neill do not explicitly disclose creating and modifying rate tables.

However, Puram discloses several tables or worksheets associated with various types of skills which candidates are allowed to access, alter or author data in a record associated with him/herself via a series of windows to fill the several tables or worksheets with the associated skills that the candidate possesses (col. 3, lines 49-58, see Figs. 5-8). In addition Puram teaches a direct correlation between candidate skills and rates charged by candidates and/or paid by employers for the combination of skills sought (col. 8, lines 61-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Puram to include rate tables for the various entered, altered skills data with the correlated rates being charged. As per teachings of Puram, it is well known in the art to create and modify information such as rate within a table or worksheet. This would allow the company to display and compare the rates charged by each candidate along with the candidate skills to identify which candidate offers the best value.

Puram does not explicitly disclose ensuring that associated hiring entities are in compliance with regard to procuring core workforce suppliers...

However, Lacy and O'Neill teach the following, wherein Lacy teaches a list of license and certifications that are required for the users' current employment position wherein the certifications are required for a given user by the user's

corporate division (**Lacy**: col. 9, lines 11-36 list of licenses and certifications; see Fig. 6, 7 certifications); and O'Neill teaches negotiating agreements with vendors and work place companies, and also teaches rules that are provided specifying the relationship between each vendor and a workplace company where the rules relate to agreements for provision of talent, and encapsulate the terms and conditions for procuring and administration of the talent. The rules also relate to the approval process required within the workplace company (**O'Neill**: ¶ [0032-0034 rules are provided specifying the relationship between each vendor and a workplace company]; see also, Fig. 3: pay rate & Fig. 4: negotiate agreement])

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the licensing and certification data of Lacy and conditions for procuring and administration of O'Neill to include additional parameter used for hiring decisions as taught by Puram in order to provide associated hiring entities with qualified candidates which will leaves a more valuable pool of candidates from which to select for subsequent positions.

In addition, Puram further discloses ...at the pre-negotiated pay rates (col. 6, line 54 – col. 7, line 2 additional parameters used by the company to make hiring decisions wherein it does not limit the type of parameter). The pay rates disclosed in Puram may be included as a type of parameter that a company may

use to make a hiring decision and wherein the associated information is stored in databases, and would make this element of the claim to be explicitly disclosed under Puram.

As per claim 19, Puram and Lacy disclose claim 18 as rejected above, but do not explicitly disclose wherein each of the commodity groups is managed by an associated commodity council entity, the commodity council entities performing:

negotiating and maintaining agreements with core workforce suppliers;

However, O'Neill discloses a talent management system (TMS) that facilitates the procurement and administration of temporary staff sourced from multiple vendors all of whom serve as a primary vendor and provides centralized corporate management and negotiation of an agreement between one or more vendors and a workplace company (¶ [0010-0011, 0028-0029 data stored in a database of the talent management system....TMS comprises a server that is coupled to a database]; see also, ¶ [0005, 0008, 0038, 0050, 0055-0057 system provides the ability to manage the procurement and administration of talent much more easily than dealing with each vendor separately....TMS provides a network based implementation of an improved process that allows workplace managers, with delegated authority, to initiate the procurement of temporary staff from corporate pre-approved suppliers using any one of a familiar manner, such as by calling, emailing or faxing the vendor while still providing]; see also, ¶ [0034;

talent management system...block 410 represents a negotiation of an agreement between one or more vendors and a workplace company)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the management of Puram and staffing requirements of Lacy to include a talent management system as taught by O'Neill in order to provide a method and system that facilitates management of temporary staff by providing tools such as reports and automatic notices to aid in management decisions.

Puram, Lacy and O'Neill do not explicitly disclose wherein adding and changing core workforce suppliers.

However, O'Neill teaches a menu created by a server that identifies functions for a staffing vendor which allows selection of creating new purchase orders, extending, confirming approval, checking, reviewing, adding and editing, reporting, and obtaining a list of service locations (§ [0039]). In addition, O'Neill teaches a direct correlation between the talent management system for facilitating the procurement and administration of temporary staff sourced from multiple vendors where corporate pre-approves suppliers (§ [0055]; see also, § [0010-0011, 0028-0029 data stored in a database of the talent management system....TMS comprises a server that is coupled to a database]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify O'Neill to include adding and changing core workforce suppliers within the corporate pre-approval supplier process already disclosed. As per teachings of O'Neill, it is well known in the art to change or update suppliers within corporate pre-approval supplier process based on the corporate decision, goals or needs for the specific company. This would give the company the assurance that all their current or new supplier needs are met on a constant basis.

Puram, Lacy and O'Neill do not explicitly disclose creating and modifying rate tables.

However, Puram discloses several tables or worksheets associated with various types of skills which candidates are allowed to access, alter or author data in a record associated with him/herself via a series of windows to fill the several tables or worksheets with the associated skills that the candidate possesses (col. 2, lines 44-58 data is stored in a storage medium...system coordinates and manages the databases; see also, col. 3, lines 49-67, see Figs. 5-8). In addition Puram teaches a direct correlation between candidate skills and rates charged by candidates and/or paid by employers for the combination of skills sought (col. 8, lines 61-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Puram to include rate tables for the various entered, altered skills data with the correlated rates being charged. As per teachings of Puram, it is well known in the art to create and modify information such as rate within a table or worksheet. This would allow the company to display and compare the rates charged by each candidate along with the candidate skills to identify which candidate offers the best value.

Puram does not explicitly disclose ensuring that associated hiring entities are in compliance with regard to procuring core workforce suppliers...

However Lacy and O'Neill explicitly teach the following, wherein Lacy teaches a list of license and certifications that are required for the users' current employment position wherein the certifications are required for a given user by the user's corporate division (**Lacy**: col. 5, line 55 – col. 6, line 11 storage device stores data defining a comprehensive skill set; see also, col. 9, lines 11-36 list of licenses and certifications; see Fig. 6, 7 certifications; see also, col. 10, lines 1-20 data stored in a storage device); and O'Neill teaches negotiating agreements with vendors and work place companies, and also teaches rules that are provided specifying the relationship between each vendor and a workplace company where the rules relate to agreements for provision of talent, and encapsulate the

terms and conditions for procuring and administration of the talent. The rules also relate to the approval process required within the workplace company

(O'Neill: ¶ [0010-0011, 0028-0029 data stored in a database of the talent management system....TMS comprises a server that is coupled to a database]; see also, ¶ [0032-0034 rules are provided specifying the relationship between each vendor and a workplace company]; see also, Fig. 3: pay rate & Fig. 4: negotiate agreement))

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the licensing and certification data of Lacy and conditions for procuring and administration of O'Neill to include additional parameter used for hiring decisions as taught by Puram in order to provide associated hiring entities with qualified candidates which will leaves a more valuable pool of candidates from which to select for subsequent positions.

In addition, Puram further discloses ...at the pre-negotiated pay rates (col. 6, line 54 – col. 7, line 2 additional parameters used by the company to make hiring decisions wherein it does not limit the type of parameter...system and method includes a database for each employer and a storage medium in which the candidate's data is stored). The pay rates disclosed in Puram may be included as a type of parameter that a company may use to make a hiring decision and

wherein the associated information is stored in databases, and would make this element of the claim to be explicitly disclosed under Puram.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puram or O'Neill in view of Lacy.

As per claim 20, Puram or O'Neill disclose claim 13 as rejected above, wherein Puram or O'Neill do not explicitly disclose

wherein hiring entities represent distinct divisions of a business enterprise seeking the supplemental worker, each of the hiring entities distinguished by geographic location, organization structure, and commodity group (Puram: col. 5, lines 35-43, preferred geographical region of employment; see also, col. 6, line 54 - col. 7, line 20, position profile, company global hiring rules).

However, Lacy teaches where entities represented in this structure could include non-profit or government entities or any other type of organizational unit, and multiple corporate divisions by Division 1 through Division N exist within the corporate structure (col.7, lines 50-67 entity hierarchical structure....corporate entity devoted to a particular product line or lines, or located within a particular geographical region...the divisions are further sub-divided into groups; see also, col. 9, lines 13-16, 49-52 particular skill required at the corporate, division, or group level; see also, col. 10, lines 5-8 entities represented in this structure could include non-profit or government entities or any other type of organizational unit).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the computer hosted method and system of Puram to include the entity hierarchical structure as taught by Lacy in order to facilitate the procurement and administration of temporary staff sourced from multiple vendors to the workplace company.

O'Neill discloses wherein each of the commodity groups is managed by an associated commodity council entity negotiating and maintaining agreements with core workforce suppliers (¶ [0005, 0008, 0034, 0038, 0050, 0055-0057 a talent management system (TMS) that facilitates the procurement and administration of temporary staff sourced from multiple vendors all of whom serve as a primary vendor and provides centralized corporate management and negotiation of an agreement between one or more vendors and a workplace company....TMS provides a network based implementation of an improved process that allows workplace managers, with delegated authority, to initiate the procurement of temporary staff from corporate pre-approved suppliers using any one of a familiar manner, such as by calling, emailing or faxing the vendor while still providing];

Puram or O'Neill does not explicitly disclose adding and changing core workforce suppliers;

However, O'Neill teaches a menu created by a server that identifies functions for a staffing vendor which allows selection of creating new purchase orders, extending, confirming approval, checking, reviewing, adding and editing, reporting, and obtaining a list of service locations (§ [0039]). In addition, O'Neill teaches a direct correlation between the talent management system for facilitating the procurement and administration of temporary staff sourced from multiple vendors where corporate pre-approves suppliers (§ [0055]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify O'Neill to include adding and changing core workforce suppliers within the corporate pre-approval supplier process already disclosed. As per teachings of O'Neill, it is well known in the art to change or update suppliers within corporate pre-approval supplier process based on the corporate decision, goals or needs for the specific company. This would give the company the assurance that all their current or new supplier needs are met on a constant basis.

Puram or O'Neill does not explicitly disclose creating and modifying rate tables;

However, Puram discloses several tables or worksheets associated with various types of skills which candidates are allowed to access, alter or author data in a

record associated with him/herself via a series of windows to fill the several tables or worksheets with the associated skills that the candidate possesses (col. 3, lines 49-58, see Figs. 5-8). In addition Puram teaches a direct correlation between candidate skills and rates charged by candidates and/or paid by employers for the combination of skills sought (col. 8, lines 61-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Puram to include rate tables for the various entered, altered skills data with the correlated rates being charged. As per teachings of Puram, it is obvious and well known in the art to create and modify information such as rate within a table or worksheet. This would allow the company to display and compare the rates charged by each candidate along with the candidate skills to identify which candidate offers the best value.

Puram does not explicitly disclose ensuring that associated hiring entities are in compliance with regard to procuring core workforce suppliers....

However, O'Neill teaches negotiating agreements with vendors and work place companies, and also teaches rules that are provided specifying the relationship between each vendor and a workplace company where the rules relate to agreements for provision of talent, and encapsulate the terms and conditions for procuring and administration of the talent. The rules also relate to the approval

process required within the workplace company (§ [0032-0034 rules are provided specifying the relationship between each vendor and a workplace company]; see also, Fig. 3: pay rate & Fig. 4: negotiate agreement)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the conditions for procuring and administration of O'Neill to include additional parameter used for hiring decisions as taught by Puram in order to provide associated hiring entities with qualified candidates which will leaves a more valuable pool of candidates from which to select for subsequent positions.

In addition, Puram further discloses ...at the pre-negotiated pay rates (col. 6, line 54 – col. 7, line 2 additional parameters used by the company to make hiring decisions wherein it does not limit the type of parameter). The pay rates disclosed in Puram may be included as a type of parameter that a company may use to make a hiring decision and wherein the associated information is stored in databases, and would make this element of the claim to be explicitly disclosed under Puram.

(10) Response to Argument

On page 6, paragraph 3 of the appeal brief, the appellant argues that:

In a first Office Action mailed May 2, 2008, the Examiner asserted, with respect to independent claims 1, 7, and 13 that Puram teaches "a data repository that stores "predefined skill types, predefined skill levels, supplier locations, and pre-negotiated pay rates." The Examiner indicated that Puram teaches these features in column 2, lines 44-58 and column 8, line 61 through column 9, line 10. However, in a response dated June 13, 2008, the Appellants provided arguments that these portions of Puram simply disclose a database that stores "needs" data 5 and "skills" data 15 (column 2, lines 44-58), but nowhere in Puram is there any teaching or suggestion of pay rates. Moreover, column 8, line 61 through column 9, line 10 of Puram do not disclose storing "pre-negotiated pay rates" in a data repository. Rather, this portion of Puram teaches a market-driven pay rate feature that utilizes market analysis provided to prospective employers to "aid their final selection of a candidate from the short list. The system tracks rates being charged candidates and/or paid by employers for the combination of skills sought" (column 8, lines 61-67; emphasis added by Appellants). These rates are not "pre-negotiated but rather signify rates the candidates expect and/or the rates of pay the employer is willing to pay for a set of skills. In addition, the market analysis enables the employer to "compare the rates charged by each candidate to the market rates to identify the candidate that offers the best value" (column 9, lines 1-10). This statement lends support to the Appellants position that the pay rates disclosed in Puram are not pre-negotiated. In fact, it is well known that market rates, by their very nature, tend to fluctuate over time and in

response to varying conditions. By contrast, pre-negotiated pay rates denote pay rates that are agreed upon and fixed in advance. Moreover, O'Neill is entirely devoid of teaching a data repository storing pre-negotiated pay rates.

In the Final Office Action mailed October 8, 2008 (page 25), the Examiner maintains that Puram does in fact disclose pre-negotiated pay rates and points to another location of Puram in support. In particular, the Examiner states that Puram teaches pre-negotiated pay rates simply "because Puram discloses additional parameters used by the company to make hiring decisions wherein it does not limit the type of parameter" (page 25, Final Office Action, October 8, 2008; emphasis added by Examiner). Thus, the Examiner equates the generalized disclosure in Puram that relates to "parameters" used by the hiring entity with the more specific pre-negotiated pay rates recited in Appellants' claims 1, 7, and 13. The Examiner then considers this to be an explicit disclosure by the reference in rejecting the claims under 35 U. S. C. 102(b). The generalized disclosure of "additional parameters" is neither an explicit (nor implicit) disclosure of "pre-negotiated pay rates." Whereupon a careful review of the entire reference fails to produce any teaching or suggestion of "pre-negotiated pay rates", it is improper for the Examiner to extend what appears to be a blanket interpretation of the "parameters" offered in Puram to include the "pre-negotiated pay rates" recited in the Appellants' claims 1, 7, and 13. Wherein an element of a claim is missing from the cited art, as is the case in the Appellants' independent claims 1, 7, and 13, the provisions of 35 U.S.C. 102 clearly stipulate that said rejection is

improper. As Puram fails to teach or suggest each and every feature recited in Appellants' claims 1 and 7, the Appellants submit that claims 1 and 7 are not anticipated by Puram.

The Examiner respectfully disagrees because as noted in the Final Action mailed October 8, 2008, Puram discloses "additional parameters" used by a company for making hiring decisions, where it does not limit the type of parameter. In addition, Puram discloses a system and method that includes a database for each employer and a storage medium where the candidate's data is stored (col. 6, line 54 - col. 7, line 2). Puram further discloses a computing device for automated data processing, where candidates' records are searched in order to find a sub-pool of candidates that possess the skills listed by the employer as desired for the position (col. 7, lines 5-20; see also Fig. 3 and associated text). Puram also discloses an exemplary table for receiving and displaying data pertaining to the skill level required for one or more skills needed for a position to be filled for use with the system and method of the present invention (col. 5, line 66 – col. 6, line 14; Fig. 9 illustrates a "requirements" or "needs" table 186 for receiving data).

Fig. 3

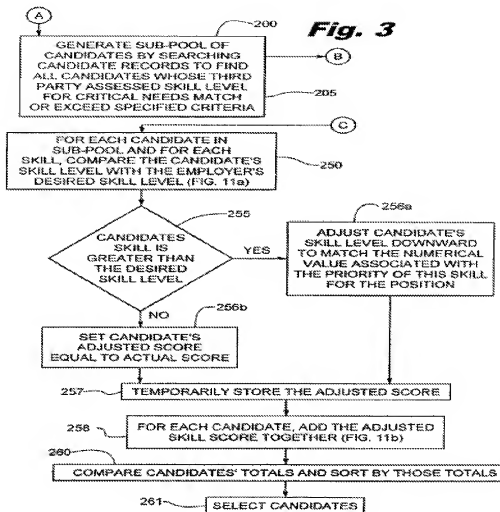


Fig. 9

Fig. 9

CORPORATION REQUIREMENTS IDENTIFICATION QUESTIONNAIRE

186	187	188	189
	SKILL CATEGORY (SAMPLE GIVEN)	MINIMUM EXPERIENCE LEVEL	SKILL LEVEL NEEDED CORE SKILLS EXPERIENCE RELEVANCE
190	HARDWARE		
	OPERATING SYSTEM		
	LANGUAGES		
	WRITING SKILLS		
	VERBAL SKILLS		
	PROJECT LEADERSHIP		
	PROJECT EXPERIENCE		

The cited prior art adds to the point that employers requesting and/or looking to hire potential candidates, do so by setting up a list of skill parameters or position requirements, where those potential candidates that qualify or meet all the requirements listed by the employer are granted a job position. Furthermore, the Final Office Action clearly defines how this statement lends support to the Examiners rejection position, where pay rates (col. 8, line 61- col. 9, line 9: rate being charged/paid for position) disclosed by Puram are implicitly included as a type of parameter that a company may use to make a hiring decision and wherein the associated information is stored in databases, and would make this element of the claim to be explicitly disclosed by Puram.

On page 8, paragraph 1 of the appeal brief, the appellant argues that:

Independent claim 13 recites a system for procuring supplemental workers for a job. Claim 13 recites features that are substantially similar to those recited in independent claims 1 and 7. As indicated above with respect to claims 1 and 7, Puram fails to teach or suggest the features recited therein. O'Neill is also devoid of teaching or suggesting "pre-negotiated pay rates," as recited in claim 13. As neither Puram nor O'Neill teach or suggest the above-referenced features recited in Appellants' claim 13, the Appellants submit that clear error exists in the rejection of claim 13. Claims 14 and 15 should be patentable over both Puram and O'Neill as they are dependent upon a patentable base claim.

The Examiner respectfully disagrees. As acknowledged by appellant where claim 13 recites features that are substantially similar to those cited in independent claims 1 and 7, Puram does in fact disclose the features recited in Claim 13, see the response to arguments for independent claims 1 and 7 noted above. With respect to appellants' argument stating O'Neill does not teach or suggest the features recited in claim 13, including the teaching or suggesting of "pre-negotiated pay rates," the Examiners disagrees because O'Neill clearly discloses the process for generating a negotiation agreement between vendors and a workplace company via a talent management system that facilitates management of temporary staff procurement and administration (Paragraph [0034]; Fig. 4 see associated text).

Figs. 3 & 4:

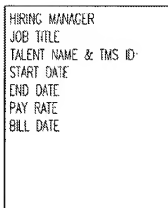


Fig.3

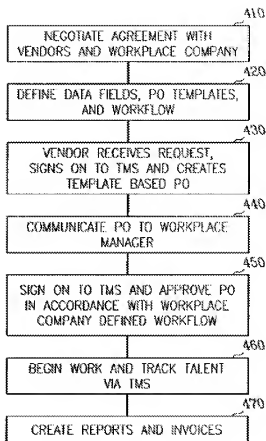


Fig.4

Fig. 4, block 410 represents a negotiation process for the agreement between one or more vendors and a workplace company [0034, 38]. O'Neill further discloses examples of data collected via multiple interfaces shown in Figs. 2 and 3; where that data collected contains talent information (see Fig. 2 and associated text). In Fig. 3, the workplace manager is identified, and a job title, talent name and unique ID, start date, end date, **pay rate** and bill rate are provided (see Fig. 3 and associated text). The information provided by the

workplace manager clearly identifies a pay rate parameter which plays a key factor in the negotiation agreement process for the talent procurement process. Therefore, the Examiner maintains that Puram or O'Neill do in fact disclose the claimed limitation recited in claim 13.

In addition the Examiner notes wherein a recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform. See MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). Please note this also applies to claims 14-15 and 20 which dependent from claim 13.

On page 8, paragraph 3 of the appeal brief, the appellant argues that:

Claims 2 and 8 depend from what should be allowable base claims 1 and 7, respectively. As Puram fails to teach each of the elements of Appellants' claims 1 and 7, the introduction of O'Neill for allegedly teaching the features of claims 2 and 8 would not cure the aforementioned deficiencies outlined with respect to claims 1 and 7. As neither Puram nor O'Neill, alone or in combination, teach, suggest, or render obvious the features recited in claims 2 and 8, the Appellants submit that clear error exists in the rejections of claims 2 and 8.

With respect to claim 2, the Examiner respectfully disagrees because it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the computer hosted method and system for selecting a candidate from a pool of candidates to fill a position disclosed by Puram to included the process of automatically generating a request form as taught by O'Neill in order to provide a method and system that includes comprehensive reporting which will therefore improve back office processes and will provide for best service practices. O'Neill teaches wherein reports are automatically generated in accordance with workflow once a purchase order is approved and wherein automatic reminders or notices are sent to the designated parties which assist in managing the talent and provides a screen shot of a menu that allows selection for creating new purchase orders (Paragraphs [0038-39] reports automatically generated, confirming approval, manage procurement and administration, creating new purchase orders; see also Paragraph [0008] providing reports and automated notices).

In addition the Examiner notes automatic operations would have been obvious to one of ordinary skill in the art at the time the invention was made to be performed using an automatic mechanism, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

With respects to Claim 8, the Examiner respectfully disagrees to appellants arguments, because it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the computer hosted method and system for selecting a candidate from a pool of candidates to fill a position disclosed by Puram to include a database where information is stored and inputted via an interface as taught by O'Neill in order to be more efficient and minimize the efforts or time to generate new purchase orders. O'Neill discloses a computer readable media that executes instructions and interfaces with different fields that gather and store information from a database (Paragraph [0028] computer executed instructions stored in a computer readable media; [0031-32] fields in the interfaces that are automatically filled with prior purchase order information gathered from database; [0038-39] reports are automatically generated in accordance to workflow rules; [0054] screens are one example of interface).

In regards to appellants' argument stating neither Puram nor O'Neill, alone or in combination, teach, suggest, or render obvious the features recited in claims 2 and 8, the Examiner points out to MPEP 2143. While there must be some teaching, reason, suggestion, or motivation that the references be combined to arrive at the claimed invention, there is no requirement that the references explicitly suggest the combination. *In re Nilssen*. 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir 1988). The suggestion or motivation to combine

the references or teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same or similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979). Furthermore, finding obviousness does not require existence of express, written motivation to combine in prior art, since motivation to combine may be found in nature of problem to be solved leading inventors to look reference relating to possible solutions to that problem. *Ruiz v. A.B. Chance Co.*, 69 USPQ2d 1686 (CA FC 2004). Additionally, the Courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine the prior art is not necessary. The motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *Id.* at 1366, 80 USPQ2d at 1649. MPEP 2143 (G). Therefore, the Examiner maintains the rejection.

On page 9, paragraph 1 of the appeal brief, the appellant argues that:

Claims 16 and 18 depend from what should be allowable base claims 1 and 7, respectively. Claims 16 and 18 recite, inter alia, "wherein hiring entities represent distinct divisions of a business enterprise seeking the supplemental worker, each of the hiring entities distinguished by geographic location, organization structure, and commodity group." The Examiner cites column 7, lines 50-67, column 9,

lines 13-16, 49-52 of Lacy in support of the rejections. While Lacy discloses an entity having a hierarchical structure, which may be sub-divided into groups, Lacy fails to teach or suggest hiring entities distinguished by all of geographic location, organization structure, and commodity group, as recited in claims 16 and 18. In fact, Lacy is entirely devoid of teaching or suggesting distinguishing hiring entities by commodity. As neither Puram nor Lacy, alone or in combination, teach, suggest, or render obvious the features recited in claims 16 and 18, the Appellants submit that clear error exists in the rejections of claims 16 and 18.

The Examiner respectfully disagrees. As acknowledged by appellant where Lacy discloses an entity having a hierarchical structure, which may be sub-divided into groups, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the computer hosted method and system for selecting a candidate from a pool of candidates to fill a position disclosed by Puram to include the entity hierarchical structure as taught by Lacy in order to facilitate the procurement and administration of temporary staff sourced from multiple vendors to the workplace company. Lacy teaches wherein entities represented in this structure could include non-profit or government entities or any other type of organizational unit, and multiple corporate divisions by Division 1 through Division N that exist within the corporate structure. Each division could, for example, represent that portion of the corporate entity devoted to a particular product line or lines, or located within a particular geographical region (col.7,

lines 50-67 entities located within a particular geographical region...the divisions are further sub-divided into groups). Therefore, Puram in view of Lacy clearly disclose wherein hiring entities represent distinct divisions of a business enterprise seeking the supplemental worker, each of the hiring entities distinguished by geographic location, organization structure, and commodity group. The Examiner maintains the rejection.

In regards to appellants' argument stating neither Puram nor Lacy, alone or in combination, teach, suggest, or render obvious the features recited in claims 16 and 18, the Examiner points out to MPEP 2143. While there must be some teaching, reason, suggestion, or motivation that the references be combined to arrive at the claimed invention, there is no requirement that the references explicitly suggest the combination. *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir 1988). The suggestion or motivation to combine the references or teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same or similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979). Furthermore, finding obviousness does not require existence of express, written motivation to combine in prior art, since motivation to combine may be found in nature of problem to be solved leading inventors to look reference relating to possible solutions to that problem. *Ruiz v. A.B. Chance Co.*, 69 USPQ2d 1686 (CA FC

2004). Additionally, the Courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine the prior art is not necessary. The motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *Id.* at 1366, 80 USPQ2d at 1649. MPEP 2143 (G). Therefore, the Examiner maintains the rejection.

On page 9, paragraph 2 of the appeal brief, the appellant argues that:

With respect to claims 17 and 19, the Examiner relies upon O'Neill for allegedly teaching "wherein each of the commodity groups is managed by an associated commodity council entity, the commodity council entities performing: negotiating and maintaining agreements with core workforce suppliers; adding and changing core workforce suppliers; creating and modifying rate tables; and ensuring that associated hiring entities are in compliance with regard to procuring core workforce suppliers at the pre-negotiated pay rates," citing paragraphs [0005], [0008], [0034], [0038], [0050], and [0055]- [0057] in support. O'Neill discloses setting job requirements; however, does not teach or suggest verifying that the hiring entities are in compliance with procuring workforce suppliers at the pre-negotiated rate. If the Examiner is equating job requirements with compliance with pay rates, then this interpretation is in error. None of the cited references, alone or in combination, teaches, suggests, or renders obvious verification or enforcement of agreements, as recited in claims 17 and 19. As none of Puram,

Lacy, and O'Neill, alone or in combination, teaches, suggests, or renders obvious the features recited in claims 17 and 19, the Appellants submit that clear error exists in the rejections of claims 17 and 19.

The Examiner respectfully disagrees because the Puram/Lacy/O'Neill combination does disclose the claimed limitation recited in claims 17 and 19. With regards to the limitation "ensuring that associated hiring entities are in compliance with regard to procuring core workforce suppliers...." Puram discloses the apparatus, method and system for finding and selecting a qualified candidate to fill a position, where Lacy and O'Neill teach the following: Lacy teaches wherein access to reports summarizing user's skill assessment data are controlled using user identification and associated passwords (col. 17, lines 16-36), and license and certification requirements for the users acquiring employment (col. 9, lines 11-36); O'Neill teaches a talent management system consisting a website tailored to the workplace company requirements; and where the websites contain permission controls for accessing vendor data [0050]. Furthermore, O'Neill teaches the process for generating a negotiation agreement between vendors and a workplace company via a talent management system that facilitates management of temporary staff procurement and administration, and rules that specify the relationship between each vendor and a workplace company (Paragraph [0034]; Fig. 4 see associated text). Fig. 4, block 410 represents a negotiation process for the agreement between one or more

vendors and a workplace company [0034, 38]. O'Neill also discloses examples of data collected via multiple interfaces shown in Figs. 2 and 3; where that data collected contains talent information (see Fig. 2 and associated text). In Fig. 3, the workplace manager is identified, and a job title, talent name and unique ID, start date, end date, *pay rate* and bill rate are provided (see Fig. 3 and associated text). The information provided by the workplace manager clearly identifies a pay rate parameter which plays a key factor in the negotiation agreement process for the talent procurement process. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Puram to include information verification techniques taught by Lacy and the negotiation agreement operation as taught by O'Neill in order to verify user's are in compliance with job requirements as per said negotiation agreement between vendors and workplace entities.

With respect to the argument pertaining to verifying that the hiring entities are in compliance with procuring workforce suppliers at the *pre-negotiated rate*, the Examiner respectfully disagrees because Puram discloses "additional parameters" used by a company for making hiring decisions, where it does not limit the type of parameter. In addition, Puram discloses a system and method that includes a database for each employer and a storage medium where the candidate's data is stored (col. 6, line 54 - col. 7, line 2). Puram further discloses a computing device for automated data processing, where candidates' records

are searched in order to find a sub-pool of candidates that possess the skills listed by the employer as desired for the position (col. 7, lines 5-20; see also Fig. 3 and associated text). Puram also discloses an exemplary table for receiving and displaying data pertaining to the skill level required for one or more skills needed for a position to be filled for use with the system and method of the present invention (col. 5, line 66 – col. 6, line 14; Fig. 9 illustrates a “requirements” or “needs” table 186 for receiving data). The cited prior art adds to the point that employers requesting and/or looking to hire potential candidates, do so by setting up a list of skill parameters or position requirements, where those potential candidates that qualify or meet all the requirements listed by the employer are granted a job position. Furthermore, the Final Office Action clearly defines how this statement lends support to the Examiners rejection position, where pay rates (col. 8, line 61- col. 9, line 9: rate being charged/paid for position) disclosed by Puram are implicitly included as a type of parameter that a company may use to make a hiring decision and wherein the associated information is stored in databases, and would make this element of the claim to be explicitly disclosed by Puram.

In regards to appellants' argument stating neither of Puram, Lacy, and O'Neill, alone or in combination, teaches, suggests, or renders obvious the features recited in claims 17 and 19, the Examiner points out to MPEP 2143. While there must be some teaching, reason, suggestion, or motivation that the references be

combined to arrive at the claimed invention, there is no requirement that the references explicitly suggest the combination. *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir 1988). The suggestion or motivation to combine the references or teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same or similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979). Furthermore, finding obviousness does not require existence of express, written motivation to combine in prior art, since motivation to combine may be found in nature of problem to be solved leading inventors to look reference relating to possible solutions to that problem. *Ruiz v. A.B. Chance Co.*, 69 USPQ2d 1686 (CA FC 2004). Additionally, the Courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine the prior art is not necessary. The motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *Id.* at 1366, 80 USPQ2d at 1649. MPEP 2143 (G). Therefore, the Examiner maintains the rejection.

On page 9, paragraph 2 of the appeal brief, the appellant argues that:

Claim 20 depends from independent claim 13. Claim 20 recites, inter alia, "wherein hiring entities represent distinct divisions of a business enterprise

seeking the supplemental worker, each of the hiring entities distinguished by geographic location, organization structure, and commodity group; and wherein each of the commodity groups is managed by an associated commodity council entity, the commodity council entities performing: negotiating and maintaining agreements with core workforce suppliers; adding and changing core workforce suppliers; creating and modifying rate tables; and ensuring that associated hiring entities are in compliance with regard to procuring core workforce suppliers at the pre-negotiated pay rates." Thus, claim 20 recites the combined features recited in claims 16/17 and 18/19. As indicated above with respect to claims 16 and 18, Lacy fails to teach or suggest hiring entities distinguished by all of geographic location, organization structure, and commodity group. Nor does Lacy teach or suggest hiring entities by commodity. Also, as indicated above with respect to claims 17 and 19, O'Neill discloses setting job requirements; however, it does not teach or suggest verifying that the hiring entities are in compliance with procuring workforce suppliers at the pre-negotiated rate. As neither Puram nor O'Neill, in view of Lacy, teach or suggest the features recited in claim 20, the Appellants submit that clear error exists in the rejection of claim 20.

The Examiner respectfully disagrees because, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the computer hosted method and system for selecting a candidate from a pool of candidates to

fill a position disclosed by Puram or the computer implemented method for staffing vendors to manage providing temporary talent to a workplace entity disclosed by O'Neill to include the entity hierarchical structure as taught by Lacy in order to facilitate the procurement and administration of temporary staff sourced from multiple vendors to a workplace company. Furthermore, O'Neill discloses a talent management system consisting a website tailored to the workplace company requirements; and where the websites contain permission controls for accessing vendor data [0050]. O'Neill further discloses the process for generating a negotiation agreement between vendors and a workplace company via a talent management system that facilitates management of temporary staff procurement and administration, and rules that specify the relationship between each vendor and a workplace company (Paragraph [0034]; Fig. 4 see associated text). Fig. 4, block 410 represents a negotiation process for the agreement between one or more vendors and a workplace company [0034, 38]. O'Neill also discloses examples of data collected via multiple interfaces shown in Figs. 2 and 3; where that data collected contains talent information (see Fig. 2 and associated text). In Fig. 3, the workplace manager is identified, and a job title, talent name and unique ID, start date, end date, *pay rate* and bill rate are provided (see Fig. 3 and associated text). The information provided by the workplace manager clearly identifies a pay rate parameter which plays a key factor in the negotiation agreement process for the talent procurement process. Furthermore, Lacy teaches wherein entities represented in this structure could

include non-profit or government entities or any other type of organizational unit, and multiple corporate divisions by Division 1 through Division N that exist within the corporate structure. Each division could, for example, represent that portion of the corporate entity devoted to a particular product line or lines, or located within a particular geographical region (col.7, lines 50-67 entities located within a particular geographical region...the divisions are further sub-divided into groups). Therefore, Puram or O'Neill in view of Lacy clearly disclose wherein hiring entities represent distinct divisions of a business enterprise seeking the supplemental worker, each of the hiring entities distinguished by geographic location, organization structure, and commodity group. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Puram to include information verification techniques taught by Lacy and the negotiation agreement operation as taught by O'Neill in order to verify user's are in compliance with job requirements as per said negotiation agreement between vendors and workplace entities.

In regards to appellants' argument stating neither Puram nor O'Neill, in view of Lacy, teach or suggest the features recited in claim 20, the Examiner points out to MPEP 2143. While there must be some teaching, reason, suggestion, or motivation that the references be combined to arrive at the claimed invention, there is no requirement that the references explicitly suggest the combination. *In re Nilssen*. 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir 1988). The

suggestion or motivation to combine the references or teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same or similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037,202 USPQ 171, 174 (CCPA 1979). Furthermore, finding obviousness does not require existence of express, written motivation to combine in prior art, since motivation to combine may be found in nature of problem to be solved leading inventors to look reference relating to possible solutions to that problem. *Ruiz v. A.B. Chance Co.*, 69 USPQ2d 1686 (CA FC 2004). Additionally, the Courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine the prior art is not necessary. The motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *Id.* at 1366, 80 USPQ2d at 1649. MPEP 2143 (G). Therefore, the Examiner maintains the rejection.

(11) Related Proceeding(s) Appendix

None

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Bob Chumpitaz/

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

*/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3629**

Vincent Millin /vm/

Appeals Practice Specialist
